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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,863	01/29/2001	William Fuller	12665.47	7795
27683	7590	12/16/2004	EXAMINER	
HAYNES AND BOONE, LLP			CHAMPAGNE, DONALD	
901 MAIN STREET, SUITE 3100			ART UNIT	
DALLAS, TX 75202			PAPER NUMBER	

3622

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/771,863

Applicant(s)

FULLER ET AL.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6-28-04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed with an amendment on 28 June 2004 have been fully considered but they are not persuasive. The arguments are addressed by revision of the last rejection and expressly at para. 7 below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. Claims 1-12 are rejected under 35 U.S.C. 103(a) as obvious over Lightfoot et al. in view of Logan et al.
4. Lightfoot et al. teaches (independent claims 1 and 8) a method and server program for distributing multimedia programming to *digital entertainment terminals 100* (col. 7 lines 34-35), which reads on distributing software over a network to a computer, the method comprising: coupling at least one advertisement to the software (col. 9 line 18); establishing, by a distributor of the programming/software, a predetermined event prior to providing the software (col. 5 lines 23-26, where said predetermined event is the advance ordering of PPV programming/ software); providing (transmitting and downloading) the programming/software with the coupled advertisement to the computer for installation (col. 9 lines 19-25 and 29-31), and allowing the programming/software to be used on the *DET/computer* in conjunction with the advertisement (col. 4 lines 47-55 and col. 9 line 18); after the predetermined event, recording/posting said usage data usage data to an external medium (*the level 2 gateway*, col. 9 lines 27-29), and continuing to allow the programming/software to be used.
5. Lightfoot et al. does not teach recording the usage data on the computer. Logan et al. teaches recording the usage on the *player 103/computer* (col. 3 lines 1-9). Because it can be best, with high usage rates, for example, to store data locally with infrequent uploads, it

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would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Logan et al. to those of Lightfoot et al.

6. The references also teach claim 8, where "the first aspect of software" and "a second aspect of the software" are respectively first and second sessions of programming/software.
7. Applicant argues (p. 5 of 6) that Lightfoot et al. does not teach a predetermined event. Para. 4 above has been rewritten to clarify what the examiner believes to be the teaching. Applicant also notes the discussion of two "aspects" of software in the specification. The examiner has reviewed that, but still finds that the references teach two aspects. The following para. 8-9 provide more details.
8. Lightfoot et al. also teaches at the citations given above claims 2, 6, 7 and 9-11. For claims 6 and 7 respectively, the limitations "associated with an advertiser" and "affiliated with a financial institution" are nonfunctional descriptive matter. See MPEP 2106.IV.B.1(b), first paragraph.
9. Claims 9-11 respectively require interpretation of the terms "song", "application program" and "game". Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...". In the instant case, the examiner is required to give the terms "song", "application program" and "game" their broadest reasonable interpretation (MPEP § 2111), so a broad variety of programming reads on the claims. In the case of claim 8, as noted in the specification, a collection of musical programs of some kind reads on "song", where "the first aspect of software" and "a second aspect of the software" are taught by some programming being free and some pay-per-view. Also, as noted in para. 6, content of any kind is nonfunctional descriptive matter.
10. Lightfoot et al. also teaches claims 3-5 at col. 5 lines 32-36.

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11. Lightfoot et al. does not teach (claim 12) uncoupling the advertisement from the software upon receipt of the payment. Logan et al. teaches permitting the user to trade-off between fee paid and amount of advertising accepted, if any (col. 9 lines 5-11), which reads on uncoupling the advertisement from the software upon receipt of the payment.
12. Claims 13-16 are rejected under 35 U.S.C. 103(a) as obvious over Lightfoot et al. in view of Logan et al. and further in view of Sterne. Neither Lightfoot et al. nor Logan et al. teaches automatically updating/replenishing ads. Sterne teaches ad rotation or flipping, which reads on automatically updating/replenishing ads. Because Sterne teaches that this helps get more impressions on a given number of pages (pieces of software), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Sterne to those of Lightfoot et al. and Logan et al.

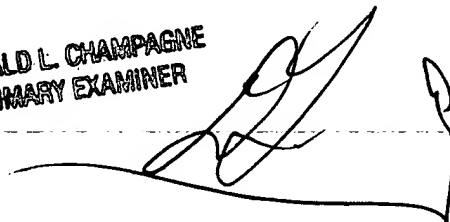
Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
14. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.

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16. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.
17. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
18. Applicant may have after final arguments considered and amendments entered by filing an RCE.
19. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

DONALD L. CHAMPAGNE
PRIMARY EXAMINER



Donald L. Champagne
Primary Examiner
Art Unit 3622 (2121 Detail)

10 December 2004